

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

NOV 21 2006

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte TOUFIC BOUBEZ, STEPHEN L. BURBECK, JAMES B. CASLER,  
STEPHEN G. GRAHAM and MARYANN HONDO

Application No. 09/753,964

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on November 8, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below:

The Examiner's Answer mailed May 3, 2006 does not list the prior art of record being relied upon in the rejections. Page 2 of the examiner's answer contains a section heading titled "**(8) Evidence Relied Upon**" that states "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal" beneath it. The Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) defines the above heading as follows:

**(8) Evidence Relied Upon.** A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

As per the above, since the examiner's 35 USC § 102(e) rejection is based on the prior art reference to Poon (U.S. Pat. No. 2002/0062265) this reference and any other evidence relied upon in the rejection(s) of the appealed claims should be listed under the "(8) Evidence Relied Upon" heading in the examiner's answer.

Correction is required.

Additionally, it is noted that one of the conferees listed in the answer (Hyung Sough) does not contain an initial/signature placed next to the typed name as required. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner to issue a revised Examiner's Answer

- a) listing the prior art of record being relied upon in the rejection(s) of the appealed claims, and

- b) to have the matter of the missing initial or signature of one of the conferees resolved, and
- c) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: G P Edgell for Dale Shaw  
DALE M. SHAW  
Acting Chief Appeals Administrator  
(571) 272-9797

DMS/vsh

cc: GREGORY M. DOUDNIKOFF  
IBM CORPORATION T81/503  
PO BOX 12195  
RESEARCH TRIANGLE PARK NC 27709